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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/008,241	01/16/1998	DAVID S. STUTZ	777.115USR	6009

26119 7590 10/07/2002

KLARQUIST SPARKMAN CAMPBELL LEIGH & WHINSTON LLP  
121 S.W. SALMON STREET  
SUITE 1600  
PORTLAND, OR 97204

EXAMINER

COURTENAY III, ST JOHN

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 10/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
09/008,241

Applicant(s)  
Stutz et al.

Examiner  
St. John Courtenay III

Art Unit  
2151



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 13, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-45 is/are allowed.
- 6) ☒ Claim(s) 46-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 15
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

ST. JOHN COURTENAY III  
PRIMARY EXAMINER

## Response to Amendment

### **Reissue Application 09/008,241 corresponding to U.S. Pat No. 5,485,617**

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
2. The specification is objected to because the certificate of correction has not been incorporated into the submitted specification. The correction should be incorporated into the specification without underlining or bracketing. MPEP 1411.01.

3. **Review of amendments filed**

The original patent claims are numbered 1-45 (U.S. Patent 5,485,617).

1-16-1998

**Preliminary amendment A (paper #4, received Nov. 6, 1998)**

- Preliminary amendment A (paper #4) added new claims 46 and 47.
- The amendment did not comply with reissue practice with respect to the underlining requirements set forth under 37 C.F.R. §1.173.

**Preliminary amendment B (paper #6, filed Dec. 17, 1999)**

- Preliminary amendment B amended patent claims 1, 17, new claim 47, and added a new claim 48.
- Preliminary amendment B did not comply with reissue practice with respect to the underlining requirements set forth under 37 C.F.R. §1.173.
- Preliminary amendment B also added improperly numbered new claims 50-53 (claim number 49 was skipped). The numbering scheme did not comply with the requirement set forth under 37 C.F.R. § 1.126:

**37 C.F.R. § 1.126 - Numbering of Claims**

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

- The Examiner renumbered by Examiner's amendment improperly numbered claims 50-53 as claims 49-52, pursuant to 37 C.F.R. §1.126.
- After entry of preliminary amendment B, claims 1-52 are pending.

**Amendment C (paper #12, received Dec. 13, 2001)**

- Amendment C copies but does not amend patent claim 1. It is unclear whether patent claim 1 was intended to be amended, as page 7 of Amendment C states: "Claims 1, 17, 27, and 45 were present in the original patent and are amended herein."
- Amendment C amends patent claim 17, patent claim 27 (typo corrected), patent claim 45, and further amends new claims 46-52, and adds a new claim 53. Claims 46-53 are presented for the first time underlined in their entirety with respect to the original patent, in compliance with 37 C.F.R. §1.173(g):
  - (g) Amendments made relative to the patent. All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

**After entry of Amendment C, claims 1-53 are pending.**

4. Applicant filed a supplemental declaration on April 24, 2002 (paper #14) that states for the first time Applicant's intention to broaden the claimed subject matter to encompass a "computer readable medium" (i.e., "*In the patent, the patentee did not claim the invention in the form of a computer readable medium*").

5. Claims 46-53 are rejected because the broadened claims (or a clear intent to broaden the claims) were not presented within two years of the patent date (Jan. 16, 1996).

6. Applicant's intent to broaden the claims was presented with the supplemental declaration received April 24, 2002 (paper #14), this being more than two years after the patent date. See 35 U.S.C. §251.

7. The claims added by amendment do not comply with reissue practice which requires Applicant to satisfy the statutory requirement of broadening within two years of the patent date. All broadening amendments were first presented more than two years after the patent date. A claim which reads on something which the original claims do not is a broadened claim. See MPEP 1412.03. As the above rejection is necessitated by Applicant's amendments to the claims, this action is made final.

**THIS ACTION IS MADE FINAL.**

Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

**How to Contact the Examiner:**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **St. John Courtenay III** whose voice telephone number is **(703) 308-5217**. A voice mail service is also available at this number.

- **All responses sent by U.S. Mail should be mailed to:**  
**Commissioner of Patents and Trademarks**  
**Washington, D.C. 20231**
- **Hand-delivered responses should be brought to Crystal Park Two, 2021 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).** All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

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**PTO FAX NUMBERS:**

- **AFTER-FINAL** faxes must be signed and sent to: **(703) 746-7238**.
- **OFFICIAL** faxes must be signed and sent to: **(703) 746-7239**.
- **NON OFFICIAL** faxes should not be signed, please send to: **(703) 746-7240**, or to Examiner Courtenay's desktop computer at **703-746-5472**.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.


To avoid ongoing Washington D.C. area mail processing delays, the Examiner requests that Applicant direct all communications to the PTO by fax. All incoming faxes are securely stored on PTO computers that are dedicated to fax reception. If you send a fax, please do not send duplicate papers via U.S. mail.

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- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: (703) 305-3900**.

**Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to: Technical Center 2100 CUSTOMER SERVICE: 703 306-5631**

Normal Flex work schedule: M – F 7:30 AM – 4:00 PM.

  
**ST. JOHN COURTENAY III**  
**PRIMARY EXAMINER**